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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,693	12/02/2003	Daniel G. Strebig	54052/42392	3406
21888	7590	08/13/2004	EXAMINER	
THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,693

Applicant(s)

STREBIG, DANIEL G.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Claim Rejections - 35 USC § 112***

Claims 2, 6, 8 and 9 (and dependent claims 3-5 and 7) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 2, 6 and 8, that part of the claim stating “the generally uncolored regions being sufficiently large to contribute to the overall appearance of the contact lens as viewed by the ordinary viewer from a distance of sixteen inches” renders the claims vague and indefinite. Specifically, any contact lens will inherently have some appearance when viewed from sixteen inches whether that appearance is colored, uncolored etc and that appearance from sixteen inches will inherently be the result of all of the features of the lens whether small, large, colored or uncolored. Therefore, the uncolored regions will inherently contribute to the overall appearance when viewed from sixteen inches and so it is not clear as to what the aforementioned is adding as a limitation rendering the claims vague and indefinite.

With respect to claim 9, that part of the claim stating that the “first plurality of the generally uncolored regions combining to have a first aggregate uncolored area” renders the claim vague and indefinite. Specifically, each uncolored region is being defined by some of the color elements. Therefore, a plurality of uncolored regions will include both colored and uncolored regions (each uncolored region being surrounded by a colored region and together they form a

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plurality of colored and uncolored areas). Therefore, claiming the first plurality of uncolored regions "combining to have a first aggregate uncolored area" creates the lack of clarity because the aggregate of a plurality of uncolored regions would inherently have to include colored areas and therefore the aggregate would be both colored and uncolored. For purposes of examination the assumed meaning is "first plurality of the generally uncolored regions combining to have a first aggregate area" (with uncolored deleted) and the same rejection applies to the claimed "second plurality of generally uncolored regions combining to have a second aggregate uncolored area".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ocampo publication number 2002/0039172.

Ocampo'172 reads on these claims by disclosing the limitations therein including the following: a colored contact lens (abstract) comprising a generally uncolored pupil region (Figure 2, paragraphs 0027-0032); a generally annular shaped iris region surrounding the pupil region and adapted to cover at least

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80% of the wearer's iris (Figure 2, paragraphs 0027-0032 re the surrounding iris region); a multicolored pattern on the iris region (Figure 2, paragraphs 0027-0032); the pattern being sufficiently colored to change the apparent color of the iris (abstract); the multicolored pattern comprising a plurality of color elements (paragraph 0027); a plurality of generally discrete uncolored regions or interstices defined by the color elements (Figure 2 and paragraph 0042 re the small clear spaces between the colored elements). The contact lens of Ocampo'172 will inherently have at least a plurality of uncolored regions or interstices sufficiently small to be undetected by an ordinary viewer from sixteen inches, this being reasonably based upon the lens requiring only two such regions or interstices of the numerous regions or interstices shown in Figure 2 to be considered as a "plurality", due to the fact that the lens is shown as having numerous minute uncolored regions or interstices (Figure 2) and just two would need to be undetected from sixteen inches by an ordinary viewer, as well as being based upon the similarity in structure to that of the claimed invention. The uncolored regions or interstices will inherently be "sufficiently large" to contribute to the overall appearance when viewed from sixteen inches by an ordinary viewer since, as stated in the 112 rejection above, any contact lens will inherently have some appearance when viewed from sixteen inches whether that appearance is colored, uncolored etc and that appearance from sixteen inches will inherently be the result of all of the features of the lens whether small, large, colored or uncolored. With respect to claim 7, it is believed that Ocampo'172 has at least three uncolored regions that are sufficiently small to be undetected by an

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ordinary viewer from sixteen inches for the same reasoning set forth above.

Therefore to satisfy the limitation of claim 7, at least two of these regions would have to have an area not greater than 1200 square microns (a majority of the plurality i.e. a majority of the claimed three). It is believed that Ocampo'172 would inherently have at least two uncolored regions with an area not greater than 1200 square microns, this being reasonably based upon the lens requiring only two such regions, due to the fact that the lens is shown as having numerous minute uncolored regions (Figure 2) and just two would need to have an area not greater than 1200 square microns, as well as being based upon the similarity in structure to that of the claimed invention. With respect to claims 9 and 10, Ocampo'172 discloses as is set forth above including the claimed annular shaped outer and inner regions (Figures 4 and 6). Again, since applicant is claiming a percentage of "a plurality" then two uncolored regions of the annular outer region would have to have an area not greater than 900 square microns to read on this limitation and just one uncolored region of the annular shaped inner region would have to have an area greater than 900 square microns to read on this limitation. It is believed that the lens of Ocampo'172 would inherently have at least two uncolored regions or interstices within the outer annular region with an area not greater than 900 square microns and at least one uncolored region or interstice within the inner annular region with an area not greater than 900 square microns for the same reasoning set forth above.

Claims 6-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ocampo publication number 2003/0025873.

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Ocampo'873 reads on these claims by disclosing the limitations therein including the following: a colored contact lens (abstract) comprising a generally uncolored pupil region (abstract, Figures 6, 11-14, 21-22); a generally annular shaped iris region surrounding the pupil region and adapted to cover at least 80% of the wearer's iris (Figures 6, 11-14, 21-22 re the surrounding iris region); a multicolored pattern on the iris region (abstract, paragraph 0011); the pattern being sufficiently colored to change the apparent color of the iris (abstract, paragraph 0011); the multicolored pattern comprising a plurality of color elements (abstract, paragraph 0011); a plurality of generally discrete uncolored regions or interstices defined by the color elements (Figures 6, 11-14, 21-22 re the small clear spaces between the colored elements, abstract, paragraphs 0011, 0054 and claim 9). The contact lens of Ocampo'873 will inherently have at least a plurality of uncolored regions or interstices sufficiently small to be undetected by an ordinary viewer from sixteen inches, this being reasonably based upon the many embodiments, and upon requiring only two such regions or interstices of the numerous regions or interstices shown in Figures 6, 11-14 and 21-22 to be considered as a "plurality", due to the many embodiments shown each with numerous minute uncolored regions or interstices and only two such areas of the may embodiments shown would require the claimed undetected by an ordinary viewer at sixteen inches (Figures 6, 11-14, 21-22), as well as being based upon the similarity in structure to that of the claimed invention. The uncolored regions or interstices will inherently be "sufficiently large" to contribute to the overall appearance when viewed from sixteen inches by an ordinary viewer since, as

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stated in the 112 rejection above, any contact lens will inherently have some appearance when viewed from sixteen inches whether that appearance is colored, uncolored etc and that appearance from sixteen inches will inherently be the result of all of the features of the lens whether small, large, colored or uncolored. With respect to claim 7, it is believed that Ocampo'873 has at least three uncolored regions that are sufficiently small to be undetected by an ordinary viewer from sixteen inches for the same reasoning set forth above. Therefore to satisfy the limitation of claim 7, at least two of these regions would have to have an area not greater than 1200 square microns (a majority of the plurality i.e. a majority of the claimed three). It is believed that Ocampo'873 would inherently have at least two uncolored regions with an area not greater than 1200 square microns, this being reasonably based upon the many embodiments shown and only two such areas of the many embodiments shown would require an area not greater than 1200 square microns, the lens requiring only two such regions, and the fact that each of the many embodiments is shown as having numerous minute uncolored regions (Figures 6, 11-14, 21-22) and just two would need to have an area not greater than 1200 square microns, as well as being based upon the similarity in structure to that of the claimed invention. With respect to claims 9 and 10, Ocampo'873 discloses as is set forth above including the claimed annular shaped outer and inner regions (Figures 6, 11-14). Again, since applicant is claiming a percentage of "a plurality" then two uncolored regions of the annular outer region would have to have an area not greater than 900 square microns to read on this limitation and just one uncolored region of the

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annular shaped inner region would have to have an area greater than 900 square microns to read on this limitation. It is believed that the lens of Ocampo'873 would inherently have at least two uncolored regions or interstices within the outer annular region with an area not greater than 900 square microns and at least one uncolored region or interstice within the inner annular region with an area not greater than 900 square microns for the same reasoning set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo'172 or Ocampo'873 in view of Tucker publication number 2003/0184710.

Ocampo'172 and Ocampo'873 disclose as is set forth above and it is believed that the claimed uncolored regions or interstices as sufficiently small to be undetected by an ordinary viewer from sixteen inches would be inherent as stated above. Regardless, Ocampo'172 and Ocampo'873 both disclose that the colored pattern can be imparted through ink jet printing (Ocampo'172, paragraphs 0015, 0057 and 0063, Ocampo'873, paragraph 0074). Tucker'710 teaches that a colored contact lens to change or enhance the apparent color of the iris of a

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person (paragraph 0002 and 0082) can be provided by printing the colored regions onto the lens through inkjet printing in which the uncolored regions would be sufficiently small to be undetected by an ordinary viewer from sixteen inches i.e. the pixels spaced less than 50 microns from each other (paragraph 0053) to provide a colored contact lens of high quality and improved appearance (paragraphs 0005 and 0082). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the colored contact lenses of Ocampo'172 or Ocampo'873 as having the claimed uncolored regions or interstices as sufficiently small to be undetected by an ordinary viewer from sixteen inches since Tucker'710 teaches of this spacing of the uncolored regions in a colored contact lens to change the apparent color of the iris for the purpose of providing a colored contact lens of high quality and improved appearance.

Prior Art Citations

Jahnke publication number 2003/0156249 and Knapp 4,582,402 are being cited herein to show contact lenses that would have either read on or made obvious claims 6-10, however, such rejections would have been repetitive. For the Knapp reference see the entire reference as well as Ocampo'172 paragraph 0005 which discusses this reference re "nearly continuous color when viewed by an ordinary viewer".

Allowable Subject Matter

Claim 1 is allowed.

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Claims 2-5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with respect to independent claim 1, none of the prior art either alone or in combination disclose or teach of the claimed colored contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed at least 1000 discrete generally uncolored regions being sufficiently small such that an ordinary viewer (as defined in the claim) cannot detect the presence of any of the 1000 generally uncolored regions from a distance of sixteen inches as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
August 11, 2004